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Typed or printed name	Terri S. Flynn		
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#12/Reply Brief
LW/ndg-
12/16/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Applicant: Thomas M. Luebke
Serial No.: 09/884,518
Filed: June 19, 2001
Title: HAND DRILL ATTACHMENT
Group Art Unit: 3711
Examiner: W. Pierce

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REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated October 8, 2003, the Appellant in the above-referenced case files the following reply. As the Examiner has not sustained the rejection of claim 11 under 35 U.S.C. Section 102(b), the issues addressed in this reply are as follows:

1. Whether claims 1 – 6 are anticipated under 35 U.S.C. Section 102(b) as anticipated by Hubscher, U.S. Patent Number 5,170,545.
2. Whether claims 1 – 16 are unpatentable over Hibbard U.S. Patent Number 4,797,040 in view of Heger U.S. Patent Number 5,352,974 under 35 U.S.C. Section 103.
3. Whether the Examiner's refusal to admit the Affidavit submitted in conjunction with the Appellant's brief was proper.

A. Rejection under 35 U.S.C. Section 102(b)

The rejection of claim 11 under 35 U.S.C. Section 102(b) has been withdrawn. The rejection of claims 1 – 6 under 35 USC Section 102(b) in view of Hubscher has been sustained. This rejection is improper and should be reversed.

I. Legal Standard

To anticipate a claim, the cited reference must show each and every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See M.P.E.P. § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also MPEP § 2131.02. "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The cited reference, however, clearly does not show all of the elements of the rejected claims, and therefore cannot anticipate these claims.

II. The Cited Reference Does not Disclose All of the Elements of Claims

1 – 6.

In his Response, the Examiner again argues that the end 15 of the Hubscher device is flat. The Examiner suggests that a "preponderance of the evidence" suggests that it is "more likely than not that the assertion is true". Furthermore, he suggests that, were the surface of a different shape, the surface profile would show the shape in the cross section. Additionally, the Examiner suggests that the surface must

be flat as a protruding surface would interfere with the operation of the device and, therefore, that one of ordinary skill in the art would not select such a surface.

In response, the Appellant notes the following: (1) A cross section would not illustrate a rounded surface as the Examiner suggests. The proof of this is adequately shown by reference to Figs. 1, 2, and 3, in which the obviously round surfaces of Figs. 2 and 3 appear flat in the cross section of Fig. 1. (2) Rounded surfaces are commonly used in reciprocating saws at the end corresponding to end 15 of Hubscher. The mere fact that the surface is not flat does not necessarily make the surface “protruding”. As proof, the Appellants attach as Exhibit A photos of commercially-available prior art saw devices which include rounded surfaces, positioned exactly where the Examiner asserts that one of ordinary skill in the art would conclude that such a surface would interfere with operation.

The preponderance of the evidence therefore does not suggest that this surface is flat. To the contrary, there is little or no evidence that the cited surface is flat. Furthermore, as the element “must be expressly or inherently described”, it is not relevant whether a preponderance of the evidence suggests that the surface is flat.

Furthermore, as Appellants noted in their Brief, the surface 15 cannot be slid across a wall surface as it would be prevented from doing so by the saw blade 65. The Examiner asserts that an apparatus must distinguish over the prior art in terms of function rather than structure. This is not the case. Functional limitations can provide distinguishing limitations in claims and should be afforded patentable weight. See, for example, *In re Land*, 368 F.2d 660 (C.P.A. 1971), *Intel Corp. v. U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832 (Fed. Circ. 1991). Here, the flat surface is slid across the wall to probe the surface for underlying subsurface objects. The limitation therefore

requires the device to be slidable over all areas of the surface in which studs are expected to exist. The Examiner suggests that the surface 15 meets this limitation because it can be placed on the wall on a corner with the blade 65 passing around the corner, and then slid along the wall. Clearly, a method which allows sliding the device only at a corner is not useful for probing for subsurface objects, and does not meet the limitations of the claim.

Moreover, the flat surface 15 does not “interface” the underlying screw gun as recited in claim 3. Webster’s New Universal Unabridged Dictionary, Barnes & Noble Books, 1996 defines the term “interface” as a surface regarded as a common boundary of two bodies. The flat surface 15 clearly does not include a common boundary with the screw gun.

Regarding the attachment member, the Examiner continues to assert that the “elongated bore” 31 is an attachment member. Referring to the specification, however, the screw gun is coupled to the housing through a V-shaped groove 27 (column 2, lines 39 - 45). The groove 27 is neither shaped like a “key slot” (claim 6), nor located adjacent the substantially flat surface (claim 4). As the Appellant noted previously, the elongated bore does not attach the adaptor to the underlying screwgun and, in fact, is “sized and configured to allow a tool bit removably received in the existing screwgun to freely rotate therein” (column 2, lines 39 – 41).

III. Conclusion with Respect to Anticipation Rejection

In his conclusion, the Examiner states that the reference “can be construed” to meet each and every limitation of the claim, and, further, that the Board should give deference to the Examiner’s determination of obviousness, citing In re Berg. The rejection here, however, is an anticipation rejection, not an obviousness rejection.

The rejection must identify each of the elements of claims 1 – 6 in a single reference. These elements must be either expressly or inherently described. Clearly, the cited reference does not anticipate the claims. The Appellants therefore respectfully request that the rejection under 35 U.S.C. Section 102(b) be reversed.

B. Rejection under 35 U.S.C. Section 103

The rejection of claims 1 – 16 under 35 U.S.C. Section 103 has been sustained by the Examiner. This rejection is improper and should be reversed. The Examiner states that the Appellant's arguments "amount to a general allegation that the claims define a patentable invention" and that no further comment is deemed necessary. The Appellant's arguments on page 6 of the Brief, however, are clearly directed to the issue of whether the Examiner has established a prima facie case of obviousness and show clearly that he has not. The Examiner's arguments impermissibly shift the burden of proof to the Appellants to provide a case of nonobviousness before a prima facie case of obviousness has been established.

I. Legal Standard. The requirements for establishing a prima facie case of obviousness are discussed in M.P.E.P. Section 2142. Section 2142 states that : "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." Furthermore, Section 2142 provides the following three criteria for establishing a prima facie case: "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

M.P.E.P. Section 2144.03 discusses the question of when it is appropriate to rely on "common knowledge" or "well known prior art". This section states that "it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record" and further, that "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support".

Therefore, the Appellants reiterate that to establish a prima facie case of obviousness, the Examiner must: (1) provide references which expressly or impliedly suggest all of the elements of the claim and (2) provide a motivation or suggestion to combine these elements. Evidence based on common knowledge or common sense which is not supported by the references can be used to "fill in the gaps", but only under limited circumstances (See M.P.E.P. Section 2144.031). Such evidence cannot be relied on without substantial support in the record as the principal evidence.

II. Application of the Legal Standard/Review of Examiner's Response

As provided in the Appellant's Brief, the Examiner has failed to establish a prima facie case of obviousness for the following reasons:

1. The Examiner has not provided references which illustrate or suggest all of the elements of the rejected claims. (Discussed in Section B(II) of the Appellant's Brief)

2. The Examiner has not provided a suggestion or motivation to combine the claims found in the prior art (Discussed in Section B(III) of Appellant's Brief); and

3. The Examiner has impermissibly relied on personal opinion and "common sense" rather than the prior art in formulating his rejection (Discussed in Section B(IV) of Appellant's Brief).

1. The references cited by the Examiner neither illustrate nor suggest the elements of the rejected claims.

The Examiner has cited two references to reject all of the claims. These references, as discussed in section B(II) of the Appellant's Brief, provide a circuit diagram for a stud seeker and a drill having a Velcro strap for holding drill bits wrapped around the outside of the drill housing. These references are wholly inadequate to illustrate or suggest the elements of claims 1 - 16.

In his reply to the Appellant's assertion that the references do not illustrate all of the elements of the claims, the Examiner not only fails to clarify where in the prior art the elements are provided or suggested, the Examiner denies that he has any obligation to cite such references, stating specifically, in fact, that the question is "not meeting the terms of the claims" but rather is based on "consideration of the ordinary skill in the art".

The Examiner goes on to deny patentability based on the fact that individual elements of the claim are not new. The Examiner states that "the Appellant is not the inventor of flat surfaces on drills" and further "the appellant is not the inventor of slot and detent type attaching means". The Appellant, however, does not claim to be the inventor of either of these features. The question at issue is not whether the Appellants invented any of the individual elements of the claims, but whether the

Examiner has shown the combination of elements in the claims is obvious based on the prior art. Such a showing cannot be accomplished by individually assessing the indicated elements of the claims. The fact that “all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings” (See M.P.E.P. Section 2143.01). Furthermore, the level of skill in the art cannot be relied upon to provide the suggestion to combine references.

In further response to the Appellants’ argument regarding these elements, the Examiner states that “one must consider the unexpected results and problems solved”. This is clearly not the case. See M.P.E.P. Sections 716.02 and 2141. Unexpected results are not a requirement of patentability but, rather, evidence of nonobviousness to be considered by the Examiner, when raised by the Appellant to combat a prima facie case of obviousness. As described above, no prima facie case of obviousness has been established. Furthermore, the Appellants have not raised the issue of unexpected results. Whether or not unexpected results exist, therefore, is irrelevant.

The Examiner, therefore, has failed to establish a prima facie case of obviousness. Furthermore, it is clear from his statements that the Examiner is applying an inappropriate standard for determining patentability, and is wrongly shifting the burden of proof to the Appellants.

2. The Examiner has failed to provide a Suggestion to Combine the Prior Art References. In response to the Appellants’ previous argument that no suggestion has been provided for combining the elements, the Examiner asserts that the “art as a whole provides ample suggestion to use both a drill and a stud sensor during construction”. And, further, that one would be “stupid” to “not consider what is

behind a wall”. Again, the Examiner misses the point. The issue here is not whether it is known to use both a stud sensor and a drill in construction, or whether it is desirable to look behind a wall before drilling. Clearly the Appellants do not deny that stud sensors and drills are used together in construction, or that stud sensors are useful in determining what is behind a wall. The use of stud sensors and drills on construction sites has, in fact, been common for decades, at least.

The issue, rather, is whether it is obvious to combine a stud sensor and a drill as recited in claims 1 and 11. The Examiner has provided no suggestion or motivation from the prior art to combine these elements as recited in the claims. His “common sense” assertions, additionally, do not suggest the combination, but vaguely suggest that both devices are useful in construction applications. Furthermore, the fact that the Examiner has been unable to illustrate such a combination despite the “numerous citations of art made that shows attaching tools that are used with a drill to the drill housing for storage and organizational purposes” and the fact that one would be “stupid” not to use the two in combination, tends to support rather than disprove the patentability of Appellants’ invention as claimed.

While the Examiner has provided broad allegations of obviousness, he has failed to cite any reference in the prior art which suggests the desirability of removably mounting a stud sensor to a drill as recited in claims 1 and 11. For this reason, also, the Examiner has also failed to provide a prima facie case of obviousness.

3. The Examiner impermissibly relies on personal experience and common sense in place of evidence of obviousness. As described in Section B(IV) of the Appellants Brief, the Examiner has relied entirely on his own personal

experience and common sense both to substitute structural limitations in the prior art and to provide for a suggestion or motivation within the references. As described above, such a standard is inappropriate if it is not based on evidence in the record. In Section B(IV) of the Examiner's response, the Examiner denies that he is under any obligation to support his own assessment, stating that, although the Appellant quoted directly from the M.P.E.P., such a requirement "clearly ... is not true".

For reasons unknown to the Appellant, the Examiner goes on to state that the word "motivation" does not appear in 35 U.S.C. Section 103(a). The Appellant agrees, but fails to see the relevance. The term "motivation" is found in M.P.E.P. 2142, which specifically states: "... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

The Examiner then goes on to give an example in which a Phillips head screw is shown as a viable alternative for a flathead screw. As the Examiner fails to explain how this example compares to Appellant's invention, the Appellant again fails to see the relevance. Clearly, for example, the substitution of a stud seeker for a drill bit, two devices which have very different functions, is not similar to the substitution of a Phillips head for a flathead screw. Similarly, a Velcro strip functions in a substantially different way from a flat attachment member with a key and slot connector. This substitution is therefore also substantially different from the cited screw example.

The Examiner further goes on to state that: "it is known in the prior art to use both drills and stud finders together during construction, to attach tools used when drilling to the housing of the drill, to provide cooperating and compatible surfaces

between devices that are attached together and to use a slot and detent type element to removably attach devices together”. As noted above, it is not proper to reject a claim based merely on the fact that the elements can be shown to be old. Additionally, the Examiner, again, fails to both show these elements in the prior art references and to provide any suggestion to combine which would lead to a proper prima facie case of obviousness. Perhaps more importantly, the Examiner ignores substantial limitations in the Appellant’s claims. The Examiner’s position apparently is that, given the fact that one device which combines an accessory for a drill with a drill exists, all such combinations are obvious. Clearly, this is not the case. The mere fact that “numerous citations of art” show “attaching tools that are used with a drill to the drill housing for storage and organizational purposes” illustrates the fallacy of this conclusion.

III. Affidavit Evidence

In conjunction with Appellant’s brief, the Appellant provided an Affidavit illustrating objective evidence of non-obviousness of the invention. The Affidavit, attached hereto as Exhibit B, was denied entry by the Examiner in an Advisory Action because “it fails to show facts that any acceptance of the product is linked to the features of the claimed invention and not by one of lower price, aggressive advertising or the like”. In his Response, the Examiner cites 37 C.F.R. 1.116 and 1.195 regarding entry of the amendment.

As discussed previously, the Affidavit confirms that the invention as claimed has been licensed by the Appellant to a major manufacturer of power tools. The manufacturer, who already makes and sells other types of drills, would have no reason to license the invention and to pay royalties to the Appellant other than the claimed invention. As the addition of a subsurface object locator, and the need to pay

royalties can only increase the price of a drill rather than decrease it, “lower price” cannot be the reason for either the license or the success in the market. Furthermore, the licensee has stated specifically in public press releases, detailed in the Affidavit, that a need for the claimed invention existed prior to the introduction to the market. Clearly, therefore, the Affidavit does show that acceptance of the product is linked to the features of the claimed invention and is not due to lower price, aggressive advertising or the like. The Affidavit clearly shows that both the license and the commercial success of the product are due to the claimed invention.

Moreover, as noted in the Appellant’s Brief, the Examiner was fully aware of the information provided in the Affidavit before a notice of appeal was filed, and refused to consider the evidence even after a copy was forwarded to him, indicating erroneously that evidence of licensing was not proper for consideration by the Patent and Trademark Office. The Appellant, therefore, had no reasonable expectation of having this evidence considered under any situation other than through intervention of the Board.

The Appellant therefore submits that the Affidavit provides substantial evidence of non-obviousness of the claimed invention. Furthermore, the Appellant has shown that a good and sufficient reason exists for having not entered this Affidavit earlier, as required by 37 C.F.R. 1.116 and 1.195. As all of the claims have been rejected as obvious, the evidence in the Affidavit, moreover, bears directly on the main issue in the case, and does not pose a “new issue”. This evidence has also already been reviewed by the Examiner, and therefore cannot prejudice his position. Failure to consider the evidence at this time will serve only to needlessly extend these proceedings, to the detriment of the Appellant, the Examiner, and the Board.

The Appellant further submits that the evidence in the Affidavit should be considered as evidence of the level of ordinary skill in the art. Throughout the prosecution, the Examiner has followed substantially the same reasoning found in his Response. The Examiner, rather than relying on prior art evidence, relies on his own opinion of what one of ordinary skill in the art would be motivated to do based on the cited references. The Examiner, however, is not one of ordinary skill in the art and has substantially mischaracterized what one of ordinary skill in the art would conclude. The Affidavit, on the other hand, provides the perspective of those who work in the art. Given the substantial reliance on opinion as opposed to facts in the present case, the Appellants believe that failure to admit an affidavit providing an opposing perspective from those who work in the art would unduly prejudice the Appellant's case.

The Appellant therefore respectfully requests that the Examiner's refusal to admit the Affidavit be overruled, and that the Affidavit be considered, both as evidence of non-obviousness and as a contrary view to the substantial "opinion" and "common sense" reasoning relied upon in the Examiner's rejection.

IV. Conclusions with Respect to Obviousness Rejection

The rejection of all of the claims in view of Hibber and Hegal is improper for the following reasons:

1. The references fail to provide all of the elements of the claims.
2. The references fail to provide a suggestion or motivation to make the claimed combination.
3. The rejection is based primarily on "common sense" and "design choice" considerations rather than evidence found in the prior art, and is therefore improper.

4. The Examiner has consistently applied improper standards to the determination of obviousness, and inappropriately placed the burden of proving that the invention was not obvious on the Appellants.

Furthermore, there is substantial objective evidence of non-obviousness. The present invention has been licensed to a major manufacturer of power tools, and has been introduced into the market with significant commercial success, as attested to in the enclosed declaration.

Based, therefore, both on the lack of evidence of obviousness and the substantial evidence of non-obviousness, the Applicants respectfully request that the rejection of claims 1 – 16 under 35 U.S.C. Section 103 be overturned.

C. CONCLUSION

The Examiner has failed to show that any of the claims are anticipated by the cited Hubscher reference. The Examiner has also failed to show that any of the claims are obvious in view of Hibbard and Hegel. The rejection of the claims, in fact, appears to be based substantially on the opinion of the Examiner that not only this, but any combination of a drill with a drill accessory would be obvious. This standard is improper and cannot be used to support the present rejection.

Furthermore, the Appellant has submitted substantial objective evidence indicating that the claimed invention is not obvious. Therefore, the Appellant respectfully requests that the rejection of the claims under 35 U.S.C. Section 102(b) and under 35 U.S.C. Section 103 be reversed.

Respectfully submitted,

Dated: December 5, 2003


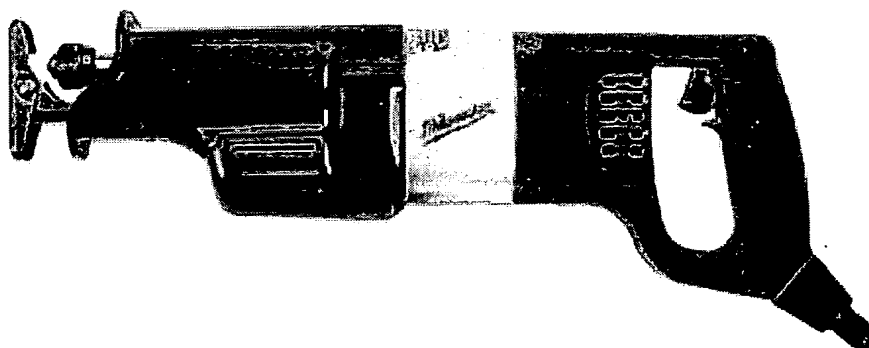
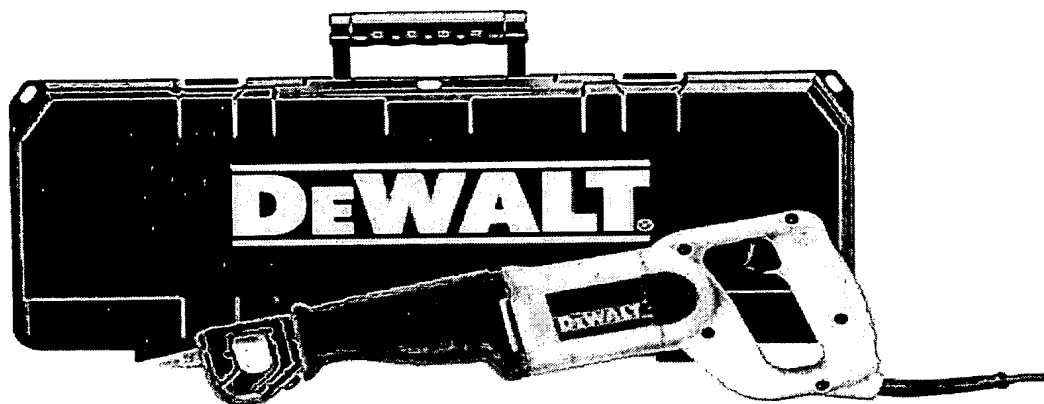
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EXHIBIT A



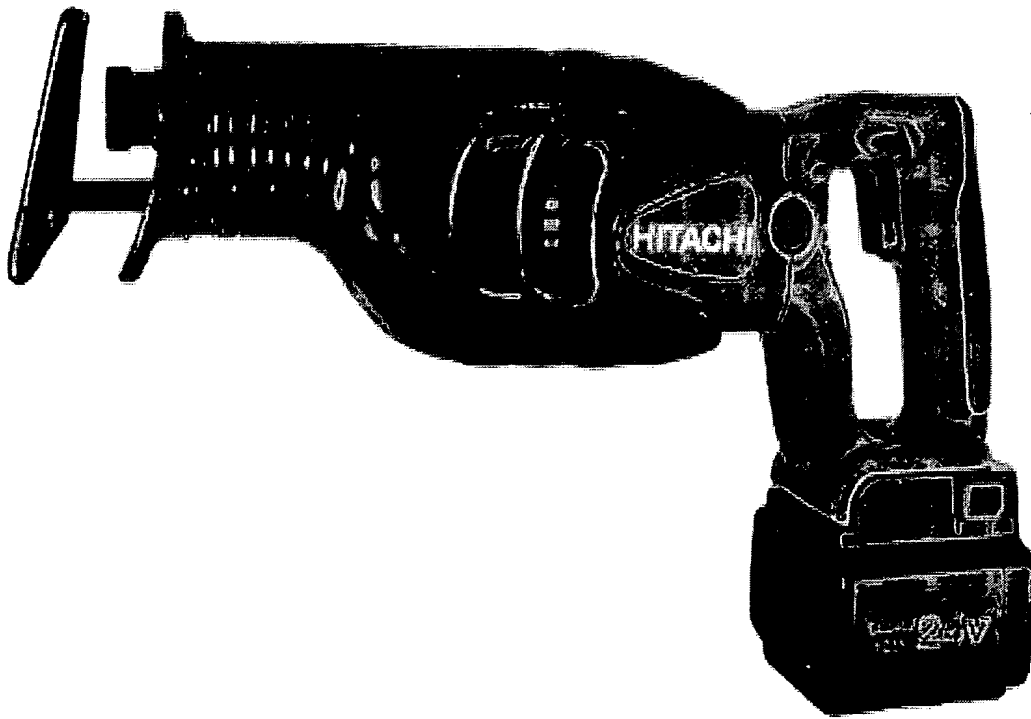
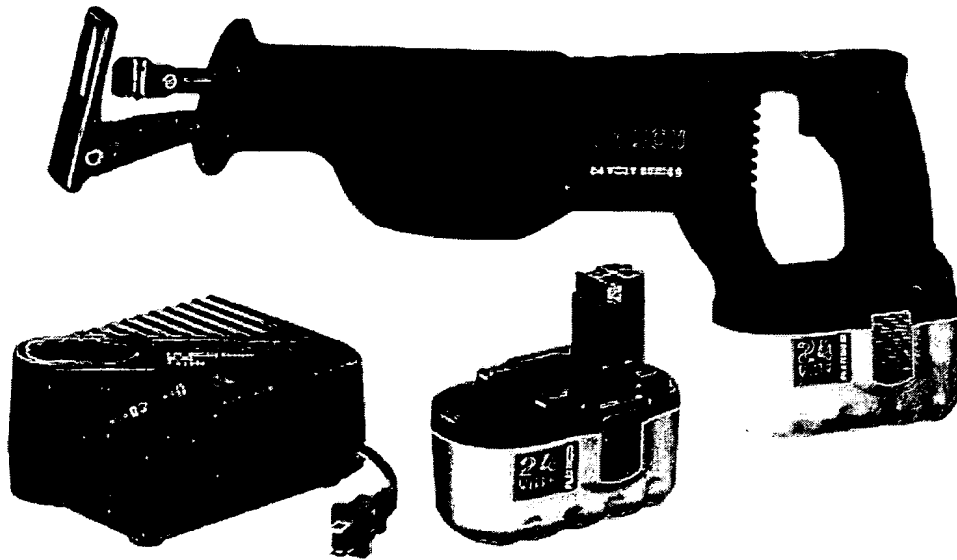


EXHIBIT B